

REMARKS

Claims 1-11 are pending in this application. Claims 1-4 stand rejected and claims 5-11 are objected to. Applicant wishes to thank the Examiner for the indication of allowable subject matter in claims 5-11. Applicant refrains from rewriting these claims in independent form until final resolution of the underlying independent claim from which it depends. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Applicant filed an Information Disclosure Statement on July 8, 2003. Applicant includes herewith a copy of the PTO-SB08 which was filed with that Information Disclosure Statement for the Examiner's convenience. Applicant respectfully requests that the Examiner initial and return the enclosed PTO-SB08.

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,689,813 ("Seki") in view of U.S. Patent No. 6,687,515 ("Kosaka"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests.

See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Simply because information is known does not make it obvious to combine that information with any reference. The Office Action must explain the reasons why one of ordinary skill in the art would be motivated to select the references or teachings and combine them. In re Rouffet, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998). A principle must be identified, known by those with ordinary skill in the art, that suggests the claimed invention. Id.

The Office Action has failed to show such a motivation in the cited references for combining the reception intensity transmitting capabilities of Seki with the device shown in Kosaka. M.P.E.P. § 2143. Absent a showing of such a motivation, a prima facie case of obviousness cannot be made. As such, if the Examiner persists in stating that such motivation is known, Applicant requests that the Examiner set forth a reference which shows such a motivation or that the Examiner submit an Examiner's affidavit indicating that such knowledge is known by one of ordinary skill in the art and that one with ordinary skill in the art would be motivated to make the above combination so that Applicant has the opportunity to rebut such an assertion. See, M.P.E.P. § 2144.03.

In the present Office Action the motivation for combining Seki and Kosaka is "for the benefit of reducing the processing time for one portable communication device to notify the opposite end its received strength." Office Action at 3. However, this motivation appears nowhere in either reference. In fact, Applicant asserts that the motivation to combine can be found only in the present specification. The present application states that a countermeasure for preventing

expected disconnection can be taken. Specification, pg. 18, ln. 8 et seq. One such countermeasure would be reduced processing time so that the entire image will be received and processed before disconnection. Thus, the Office Action has not established a *prima facie* case of obviousness by citing a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the cited references to arrive at the claimed subject matter. Therefore Applicant requests reconsideration and allowance of claim 1.

Claim 2 recites that the portable communication terminal of claim 1 further comprises “reception electric field intensity transmission setting means for setting whether or not the reception electric field intensity image should be transmitted.” This feature is not present in Seki as asserted in the Office Action.

In Seki, there is no setting means. In Seki, there are intensity levels which have different meanings regarding the ability of the Seki device to communicate. However, there are no setting means disclosed in Seki. As such, the explicitly recited limitation in claim 2 is not disclosed in Seki. Therefore, Applicant respectfully requests allowance of claim 2.

Claim 3 recites transmission means for transmitting a communication quality alarm image to the opposite party of communication when a communication quality alarm is generated. This feature is not present in Seki.

In Seki, there are four intensity levels which relate to the ability of the apparatus to communicate. However, these intensity level signals, which can be displayed, are not communicated to the opposite party of communication. Thus, claim 3 is allowable over the cited combination.

Claim 4 recites setting means for setting whether or not a communication quality alarm should be transmitted. As discussed above, Seki does not disclose transmitting a communication quality alarm. Therefore, Seki is silent as to setting means for communicating the alarm. Therefore, Applicant respectfully asserts that like claims 1-3, claim 4 is also allowable over the cited references.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Application No.: 09/975,233

Docket No.: H2041.0064

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated:

Respectfully submitted,

By 

Ian R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &
OSHINSKY LLP

1177 Avenue of the Americas

New York, New York 10036-2714

(212) 835-1400

Attorneys for Applicant

IRB/mgs

Attachment (Copy of PTO - SB-O8, filed 7/8/03)